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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91194706
Party	Plaintiff 1047406 Ontario Ltd. and Purifics ES, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

1047406 Ontario Ltd. and)	
Purifics ES, Inc.,)	
)	
Opposers)	Opposition No.: 91,194,706
)	
v.)	
)	
UVCleaning Systems, Inc., dba Puralytics)	
Corporation,)	
)	
Applicant.)	

REPLY BRIEF OF OPPOSERS 1047406 ONTARIO LTD. AND PURIFICS, ES, INC.

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I. INTRODUCTION

In this proceeding, Applicant is asking the Board to ignore what Applicant has stated and included in its own Application. However, case law confirms that an applicant is bound by the contents of its application, regardless of extrinsic evidence. In addition to Applicant's attempt to jettison its own intent-to-use Application, it has impermissibly sought to introduce evidence of third-party websites and hearsay that is inadmissible. Applicant has also sought to arbitrarily dissect the parties' marks in an attempt to draw an artificial distinction between the same goods/services, trade channels, and classes of consumers.

As stated in Opposers' Main Brief, the core issue is what Applicant stated and included in its Application versus Opposers' registered and common-law rights in their "PURIFICS" mark. In this Reply Brief, Opposers have further demonstrated their common-law rights in the "PURIFICS" mark with water purification goods. Moreover, Opposers have demonstrated the broad scope of Applicant's Application, the inadmissibility of alleged third-party use of marks beginning with "PUR," and Opposers' sufficient policing of their mark. Based on the applicable facts and law, as discussed in Opposers' Main and Reply Briefs, a likelihood of confusion exists between Opposers' "PURIFICS" mark and Applicant's "PURALYTICS" mark for water purification goods and services.

II. ARGUMENTS AND AUTHORITIES

A. Applicant Is Bound By The Contents Of Its Application Regardless Of Extrinsic Evidence

Applicant devotes much of its Main Brief to improperly attempting to limit its trade channels, class of purchasers and types of goods by offering evidence outside of its intent-to-use Application. The law is clear that Applicant's reliance on extrinsic evidence is impermissible. The Board must consider **only** Applicant's description of its goods and the limitations (if any) to its trade channels and class of consumers recited in the Application. By continuing to rely on

extrinsic evidence to limit its types of goods, trade channels and classes of consumers, Applicant ignores the express mandate of the Federal Circuit Court of Appeals:

The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

See Octocom Sys., Inc. v. Houston Computer Services, Inc., 918 F.2d 937, 941-42, 16 U.S.P.Q.2d 1783 (Fed. Cir. 1990) (emphasis added).

Applicant did not limit the proposed goods in its Application to a subset of water purification goods. Only now does Applicant attempt to distinguish its water purification goods from Opposers' water purification goods and services. However, Applicant's limitation is impermissible under the law. *Id.* (registrability of applicant's mark decided on what is identified in application regardless of what record discloses about nature of goods).

Further, Applicant did not limit the proposed trade channels or proposed class of consumers in its Application. Accordingly, the Board must presume that Applicant's and Opposers' closely-related goods move in all channels of trade normal for those goods, and that the goods are available to all classes of purchasers of those goods. *Id.* As the master of its own Application, Applicant is estopped from rewriting or recharacterizing its Application now.

B. Third-Party Website Screenshots and Registrations For Unrelated "PUR" Marks

1. Evidence Of Third-Party Website Screenshots Is Inadmissible

In responding to Opposers' objections to Applicant's third-party website screenshots, Applicant ignores both the Trademark Manual of Board Procedure and case law. Moreover, Applicant attempts to circumvent its failure to properly authenticate the third-party website screenshots by relying on testimony from its counsel's employees. By not providing the URL

and dates on the third-party website screenshots during the discovery period (as case law requires), Applicant divested Opposers of "the opportunity to verify the documents" or effectively cross-examine Applicant's witnesses. *Safer Inc. v. OMS Investments Inc.*, 94 U.S.P.Q.2d 1031, 1039 (T.T.A.B. 2010). In *Safer*, the Board explained that the Internet is transitory in nature, and "the risk that the website owner may change the information contained therein" is a matter that the non-offering party should have an opportunity to rebut or address. *Id.*

Applicant cannot now rely on testimony from its counsel's paralegals during the testimony period without any means for Opposers to verify the authenticity or materiality of the third-party website screenshots - an opportunity Opposers would have otherwise had during the discovery period if Applicant had complied with the Board's authentication requirements. Applicant's failure to comply with this evidentiary requirement is reason alone for the Board to decline to admit Applicant's unauthenticated website screenshots from various third parties.

Further, to the extent that Applicant can overcome the Board's published authentication requirements for website screenshots, the website screenshots could be admitted on only very narrow grounds and given little (if any) weight. As discussed in Opposers' Main Brief, Applicant has no evidence of third-party use in connection with the third-party website screenshots. *See* Opposers' Main Brief, pp. 3-5. To properly introduce evidence of third-party use, the offering party must establish: (1) third parties actually used the identified mark, (2) third parties promoted the marks well, and (3) consumers recognized the marks. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 U.S.P.Q. 1689, 1693 (Fed. Cir. 2005).

With no evidence in the record of the above three factors, the third-party website screenshots command at most, minimal probative value. *Id.* (printout from webpage may have

more limitations on its probative value than traditional printed publications; absent testimony and proof of extent of website viewing, printout might not have much probative value). Opposers respectfully submit that Applicant's third-party website screenshots are inadmissible because they have failed to properly authenticate them. Alternatively, Opposers submit that the third-party screenshots, if admitted, have no evidentiary value in this proceeding because they do not meet the 3-part test for showing third-party use of a mark.

2. Applicant's Third-Party Registrations Should Be Given Little Weight

Applicant's third-party registrations are not admissible as evidence of third-party use to show that Opposers' "PURIFICS" mark is allegedly weak. Applicant submitted third-party registrations that have nothing to do with water purification. For example, Applicant cites seven third-party registrations beginning with the prefix "PUR," shown in the chart below. The cited "PUR" registrations are not directed to water purification goods or services, and therefore have no relevance in this proceeding.

Registration No./Mark	Description of Goods/Services
3,350,098 for "PURICORE"	Int'l Class 42: Development of new technology for others in the field of biocide sterilizing systems with medical, dental, pharmaceutical, industrial, manufacturing, water treatment and public safety applications
3,364,913 for "PURION"	Int'l Class 11: Environmental Control Apparatus , Namely, Magnetic Apparatus for Conditioning Water for Use in Homes, Buildings, Boilers, Automobiles and Industry
3,934,473 for "PURITECH"	Int'l Class 7: Machines for filling bottles and containers with drinking water for domestic and commercial use
3,927,771 for "PURITEC"	Int'l Class 9: Industrial radiation apparatus for laboratory use, namely, radiation devices for the detection, analysis and treatment of fluid-borne pathogens by application of radiation in the 180-800 nanometer wavelength range, and component parts of the aforesaid goods, namely, 180-800 nanometer light sources, submerging radiation units and UV sterilization units for water disinfection
3,490,868 for "PURICA"	Int'l Class 3: Cosmetics , namely, lipstick, lipliner, lipgloss, foundation and concealer, facial powders and blush, mascara, eye shadow, eyeliner, eyebrow pencils, makeup remover, nail polish, nail polish remover; skin care products, namely, skin cleansers, soaps, skin masks, face cream, eye cream, moisturizers, hand and body lotions and salves, suntan lotion and cream,

	toner, astringents and depilatories, bath oils, bath and shower gels, bubble bath, bath crystals, bath grains, bath salts, soaps, body scrubs, body massage oils; hair care products, namely, shampoo, conditioner and treatments, hair coloring preparations, hair permanents, hair relaxers, mousse, styling and setting lotions, hairspray, hair thickener, glazes and texturizers; Household cleaning products, namely, all-purpose household cleaners, dishwashing detergent, laundry soap and dish soap
2,977,204 for "PUROCLEAN"	Int'l Class 37: Property restoration services , namely, cleaning and restoring of commercial, industrial and residential buildings and personal property contained therein to remove smoke, odor, water, chemical contamination, mold and other bio-hazardous substances and to dehumidify and dry building interiors and contents; commercial, industrial and residential building restoration, emergency response in the field of real property and contents, damage, namely, stabilization of property, damage containment and immediate mitigation
1,500,440 for "PURA-TECH"	Int'l Class 11: Water distiller and a water conditioner including reverse osmosis filtration

For the remaining "PUR" registrations that are directed to water purification services, Applicant ignores the entireties of the marks at issue in this opposition: "PURIFICS" and "PURALYTICS." As discussed in Opposers' Main Brief and below¹, the contested marks are not restricted to "PUR" and cannot be dissected as such. Even if the Board were to dissect the marks as Applicant proposes, the third-party registrations would still have very limited probative value.

Applicant relies on *Miguel Torres S.A. v. Bodegas Muga S.A.*, 176 F. App'x 124 (Fed. Cir. 2006) for the proposition that third-party registrations have some probative value. The *Miguel Torres* court relied on not only the sheer number, but also the "geographical distribution" of the applicant's examples of third-party use to give some probative value to the third-party registrations. Here, Applicant has not submitted any "geographical distribution" information for the marks listed in the third-party registrations. As such, Applicant has not brought the cited

¹ See *infra*, Section F.

registrations within the *Miguel Torres* case and has not demonstrated that the cited third-party registrations should be given any probative value.

Applicant also relies on *PC Club v. Primex Technologies, Inc.*, 32 F. App'x 576 (Fed. Cir. 2002) for the similar proposition that third-party registrations are of probative value to the strength of the marks. In *PC Club*, the Federal Circuit Court of Appeals affirmed the Board's use of third-party registrations of phonetic equivalents of the mark to gauge the strength of that mark. *Id.*, *aff'g* 2000 T.T.A.B. LEXIS 857, at *18 (T.T.A.B. Nov. 30, 2000). The facts of the *PC Club* case and its restrictive holding are different from the facts before the Board in this proceeding.

Applicant has not cited registrations for third-party marks that are phonetic equivalents of the "PURIFICS" mark. Rather, Applicant cites third-party registrations only because the marks identified in those registrations incorporate the prefix "PUR." As Applicant's third-party registrations do not contain any phonetic equivalents of the "PURIFICS" mark, those registrations do not come within the rationale of the *PC Club* case, and should be given minimal (if any) probative value in the Board's likelihood of confusion analysis.

C. Similarity Of Goods/Services - Applicant's Goods Are Closely Related To Opposers' Goods And Services

Applicant's water purification goods are similar to Opposers' water purification goods and services. Applicant's water purification goods are similar to Opposers' water purification goods and services. Moreover, Applicant's failed attempt to convince the Board that Opposers have no common-law rights in their "PURIFICS" mark is at odds with Opposers' evidence and testimony. Inapposite to Opposers' arguments (which are supported by evidence), Applicant attempts to enter extrinsic evidence of Applicant's goods beyond the goods listed in its Application. As discussed below, both of Applicant's argument equally fail.

1. Opposers Pled Their Common-Law Mark With Water Purification Goods In Their Notice of Opposition

Applicant claims that Opposers have not alleged common-law rights in their "PURIFICS" mark with water purification goods. *See* Applicant's Main Brief, p. 22. This is contrary to the Notice of Opposition and the evidence of record. Opposers alleged common-law rights in their Notice of Opposition. *See, e.g.,* Notice of Opposition, ¶ 4. In addition, the electronic form accompanying the Notice of Opposition identified the registered "PURIFICS" mark and the common-law "PURIFICS" mark as the bases for this Opposition. Clearly, Opposers alleged their common-law rights in the "PURIFICS" mark for water purification goods. Moreover, the exhibits accompanying Opposers' Notice of Opposition included screenshots of Opposers' website showing use of the common-law "PURIFICS" mark with water purification goods. *See* Exhibit B to Notice of Opposition (*e.g.,* "PURIFICS" mark affixed to Opposers' water purification devices).

Opposers have also proven their common-law rights in the "PURIFICS" mark with water purification goods. For example, Opposers' President Brian Butters testified about Opposers making, selling, and distributing "PURIFICS" water purification devices since 1993, and Opposers distributing their water purification devices throughout the United States.² The record shows that Opposers properly alleged their common-law rights in the "PURIFICS" mark with water purification goods in the Notice of Opposition, and have demonstrated their common-law rights in the "PURIFICS" mark with water purification goods for many years.

² Deposition of Brian Butters, October 10, 2012 ("Butters Depo."), 11:20-21.

2. Opposers' Registered Mark Is For Services Related To Applicant's Goods

Applicant argues that its Application is directed to goods, whereas Opposers' Registration is directed to services. According to Applicant, that is the end of the discussion. This cursory conclusion ignores both the nature of the water purification industry and a wealth of case law. The fact that Applicant's Application recites goods and Opposers' Registration recites services does not change the fact that the parties' goods and services are closely related for purposes of determining likelihood of confusion. It is well recognized that confusion is likely to occur from the use of similar marks for goods, on the one hand, and for services involving those goods, on the other. *See, e.g., In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 U.S.P.Q.2d 1025 (Fed. Cir. 1988) ("BIGG'S" (stylized) for retail grocery and general merchandise store services likely to be confused with BIGGS & Design for furniture); *In re H.J. Seiler Co.*, 289 F.2d 674, 129 U.S.P.Q. 347 (C.C.P.A. 1961) ("SEILER" for catering services likely to be confused with "SEILER'S" for smoked and cured meats).

The goods and services associated with the contested marks are, in fact, closely related. Applicant's Application recites "waste water purification units; water purification and filtration apparatus; water purification units." (emphasis added). Opposers' Registration recites "environmental remediation services, namely, soil, waste and water treatment services and air purification services." (emphasis added). The evidence of record documents that Opposers use their common-law "PURIFICS" mark with water purification and water filtration goods.³ It is without credible dispute that water treatment services encompasses water purification services. Likewise, Applicant's goods recited in its Application are the same as the goods offered under Opposers' common-law mark: water purification goods.

³Butters Depo., 25:19 - 28:2 and Ex. 14.

Applicant's description of its goods in its Application encompasses all goods capable of water purification and filtration, not just a particular subset of such goods. Likewise, Opposers' Registration recites, *inter alia*, "water treatment services," without limitation. The parties' goods and services relate to water purification in general (*i.e.*, with no limitations). It is common sense that water treatment includes filtering and purifying water.⁴ What Applicant suggests now - that its water purification goods are fundamentally different from Opposers' water treatment services - runs counter to common sense. Accordingly, when comparing the parties' identified goods and services, the Board should conclude that they are related, if not effectively identical. This factor weighs heavily in favor of finding a likelihood of confusion.

3. Applicant's "Key Phrase" Analysis Has No Legal Support

In trying to differentiate the parties' goods and services, Applicant uses a "key phrase" analysis. Applicant argues that the "key phrase" in its description of goods in its Application is different from that of Opposers' description of services in their registration. Applicant does not cite any legal authority for this "key phrase" analysis, nor have Opposers been able to locate any. In fact, Applicant's "key phrase" analysis runs counter to trademark law and would stand a likelihood of confusion analysis on its head.

Section 1207.01(a)(iii) of the TMEP states that without any limitation to the description of goods or services, analysis for likelihood of confusion regarding a cited registration "encompasses all goods or services of the type described." Equally as important, "an applicant

⁴ Opposers ask the Board to take judicial notice that water purification and filtration are different types of water treatment as common knowledge or accepted knowledge from various state and federal agencies, *e.g.*, the U.S. Environmental Protection Agency (www.epa.gov/learn/kids/drinkingwater/watertreatmentplant_index.cfm) and the Washington State Department of Health (www.doh.wa.gov/Emergencies/EmergencyPreparednessandResponse/Factsheets/WaterPurification.aspx). See *In re Tokutake Industry Co.*, 87 USPQ2d 1697, 1700, n.1 (T.T.A.B. 2008) (Board taking judicial notice of census data issued by U.S. government); *In re Perry Manufacturing Co.*, 12 U.S.P.Q.2d 1751, 1752 (T.T.A.B. 1989) (Board taking judicial notice of common knowledge that New York is world-renowned center of culture and high fashion and people from throughout world go to New York to purchase latest styles in clothing, from haute couture to off-the-rack garments).

does not avoid likelihood of confusion merely by more narrowly identifying" the goods or services. *Id.* (citations omitted). Likewise, the Board has stated that "[l]ikelihood of confusion must be found if there is likelihood of confusion involving *any* item that comes within the identification of goods" in comparing the application to the cited registration. *In re Jump Designs LLC*, 80 U.S.P.Q.2d 1370, 1374 (T.T.A.B. 2006) (emphasis in original). Applicant's "key phrase" analysis is nothing more than an attempt to narrow the goods in Applicant's Application and the services in Opposers' registration.

D. Similarity Of Trade Channels - Opposers And Applicant Have The Same Or Overlapping Trade Channels

1. Applicant Did Not Limit Its Description Of Proposed Trade Channels In Its Application

Applicant argues that the parties operate in different trade channels. However, Applicant's Application contains **no restrictions** on the proposed trade channels for Applicant's goods. It is black-letter law that an applicant cannot offer testimony or evidence at a later time to restrict its trade channels as originally identified in its application. *Octocom Systems, Inc.*, 918 F.2d at 943, 16 U.S.P.Q.2d at 1787-88 ("an application with an identification of goods having no restriction on trade channels obviously is not narrowed by testimony"); *In re Davey Products Pty Ltd.*, 92 U.S.P.Q.2d 1198, 1203 (T.T.A.B. 2009) ("[b]ecause neither applicant's identification of goods nor registrant's identification of [services] includes any restrictions or limitations as to trade channels, we presume that the respective goods [and services] are or would be marketed in all normal trade channels"). That is precisely what Applicant is trying to do here.

Neither Applicant nor Opposers restricted their trade channels in their respective Application/Registration. Therefore, the Board must presume that the parties' goods and services travel in the same trade channels and reject Applicant's extrinsic evidence that it employs

different trade channels than Opposers. *Octocom*, 918 F.2d at 943, 16 U.S.P.Q.2d at 1787-88; *In re Davey Products*, 92 U.S.P.Q.2d at 1203.

2. Applicant's Actual Trade Channels Are The Same As Opposers' Trade Channels

The Board should reject Applicant's attempt to offer extrinsic evidence of its trade channels. First, extrinsic evidence is particularly inappropriate for consideration where the contested application is an intent-to-use application, as is the case here. *See, e.g., In re Vibrynt, Inc.*, 2012 T.T.A.B. LEXIS 273, *12-14 (T.T.A.B. July 20, 2012) (for contested intent-to-use application, analysis must be based on identifications of goods as identified in respective application and cited registration (citing *In re Trackmobile, Inc.*, 15 U.S.P.Q.2d 1152, 1153 (T.T.A.B. 1990))). Indeed, it is a “well established ruled of law that ‘the Board must compare applicant’s goods as set forth in its application with the goods as set forth in the cited registration. It is improper to decide the issue of likelihood of confusion based upon a comparison of applicant’s actual goods with registrant’s actual goods.’” *Id.*

In the unlikely event that the Board considers Applicant's extrinsic evidence of its trade channels, the Board should conclude that Applicant offers its water purification goods in the same trade channels that Opposers use to offer and promote their water purification goods and services. Specifically, that extrinsic evidence would show that both Applicant and Opposers have attended the same trade shows, conferences and meetings, and have written articles and white papers to offer and promote their water purification goods and services.⁵

For example, both Applicant and Opposers attended the Artemis Project awards presentation and the Water Tech conference, which occurred last year.⁶ Also, Applicant and

⁵ Butters Depo., 28:3 – 39:2 and Exs. 14-20.

⁶ Butters Depo., 28:3 - 39:2.

Opposers have been listed in the same articles or publications.⁷ In light of the above, Applicant and Opposers have the same and/or overlapping trade channels. This factor favors a likelihood of confusion.

E. Similarity Of Consumers - Opposers And Applicant Have The Same Or Overlapping Customers

1. Applicant Did Not Limit Classes Of Customers In Its Application

Applicant also offers extrinsic evidence to try to differentiate its classes of customers from Opposers' classes of customers. But Applicant's Application did not limit in any way the types of customers that might purchase its water purification goods. Thus, Applicant's goods, as listed in its description of goods in its Application, are presumed available to all classes of purchasers. *See, e.g., In re Jump Designs*, 80 U.S.P.Q.2d at 1374 (when there is no limitation on class of purchasers in description of goods, Board may presume that goods "would be purchased by all potential buyers thereof"); *In re Elbaum*, 211 U.S.P.Q. 639, 640 (T.T.A.B. 1981) (where no limitation on classes of purchases, must be presumed that goods purchased by "all potential customers").

2. Applicant Has Unsophisticated Consumers And Even Its Sophisticated Consumers Are Not Immune To A Likelihood of Confusion

Applicant asks the Board to believe that Applicant's customers are sophisticated, thus mitigating any likelihood of confusion. Even if the Board were to consider Applicant's extrinsic evidence (which it should not), Applicant's argument fails for at least these reasons.

a. Applicant Has Unsophisticated Consumers

Applicant's Main Brief glosses over the fact that it has unsophisticated consumers. It is noteworthy that Applicant's description of goods in its Application covers two product lines: (1)

⁷ Butters Depo., 42:18 - 43:1.

a portable water purification bag (such as used for camping); and (2) an electric/electronic device roughly sized to fit on a desk or lab bench aimed at industrial or academic settings.⁸

Applicant's corporate representative testified about the sophistication level of customers for each of its two product lines. Regarding the first product line, Applicant testified that children and other retail consumers may be the end consumer for its portable water purification bags offered under Applicant's mark.⁹ Applicant also admitted that its portable water purification bags have **no** restriction regarding who can purchase them at online retail outlets such as Amazon.com and Sportsmansguide.com.¹⁰ Applicant argues that the customers for its electric/electronic water purification devices (its second product line) are sophisticated consumers who do their homework before purchasing those types of water purification devices.

Clearly, there is a mixture of sophistication levels of customers for Applicant's two product lines. The law is clear that when there is a mixture of sophisticated and unsophisticated purchasers, the degree of care assumed is the **lower** level of sophistication, *i.e.*, the casual, unsophisticated consumer. *Nikon, Inc. v. Ikon Corp.*, 803 F. Supp. 910, 924 (S.D.N.Y. 1992) (“Although very sophisticated purchasers of Nikon's high priced SLR cameras might not confuse an IKON brand camera with a NIKON brand camera, unsophisticated consumers of lower priced cameras might very well believe IKONs are made by or affiliated with Nikon. Such consumers are likely to associate Ikon's 110 and manual 35 mm cameras with Nikon's quality photographic equipment.”); 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 23:100 (4th Ed. 2012); *Country Floors v. Gepner*, 930 F.2d 1056, 1065 (3d Cir. 1991) (even if most customers

⁸ See Deposition of Mark Owen, September 20, 2012 (“Owen September Depo.”), 37:20 - 38:2.

⁹ Owen September Depo., 45:18 - 46:2.

¹⁰ Owen September Depo., 46:15 - 48:18.

are professionals, trademark law protects "the **entire gamut** of purchasers, including retail consumers") (emphasis added).

In addition, while all purchasers may be sophisticated, the likelihood of confusion analysis must also consider the sophistication of **users** of the goods. In *Octocom*, the Federal Circuit discussed this issue as it relates to purchasers v. users of computer modems and computer programs. 918 F.2d at 942-43, 16 U.S.P.Q.2d at 1787. Confirming the Board's decision on lack of sophistication, the Federal Circuit noted that "the alleged expertise of purchasing agents...[was] neither controlling nor persuasive....[because] confusion had to be considered with respect to users as well as actual purchasers." *Id.* The same is true here. While some purchasers of Applicant's goods may be sophisticated, Applicant has also testified about unsophisticated **users** of its water purification goods.¹¹

Therefore, even if the Board were to allow Applicant's extrinsic evidence to limit the description of water purification goods in its Application, the Board would still have to consider the level of sophistication of purchasers and users based on the first product line (portable solar bags). That is, the degree of care would center around retail customers and users, and even children, who are unsophisticated.

b. Even Sophisticated Consumers May Be Confused

Even assuming that all of Applicant's customers are sophisticated (which they are not), the law is also clear that "even sophisticated consumers are not necessarily knowledgeable in the field of trademarks, and as such, not immune from trademark confusion. *In re Davey Products*, 95 U.S.P.Q.2d at 1204; *In re Linkvest S.A.*, 24 U.S.P.Q.2d 1716 (T.T.A.B. 1992). As the Board

¹¹ Owen September Depo., 45:18 – 48:8 and Exs. 5-7.

reasoned in *Linkvest*, "[e]xpertise in a particular field does not necessarily endow one with expertise in connection with the use of a trademark." *In re Linkvest*, 24 U.S.P.Q.2d at 1716.

The same may be said here. Just because Applicant posits that its customers are sophisticated, there is no evidence to suggest that its customers are immune from trademark confusion. The facts demonstrate the opposite - Applicant's so-called sophisticated consumers also include the consuming public who purchase inexpensive, portable solar bags on Amazon.com, as well as recreational users such as campers.¹²

c. Opposers Have Not Restricted Their Consumers

Applicant argues that Opposers' customers are sophisticated, thus mitigating any likelihood of confusion. Applicant's Main Brief, p. 33. This argument is not relevant to the Board's likelihood of confusion analysis. In *In re Thor Tech, Inc.*, the applicant made a similar argument against a cited registration for denial of registration under § 2(d). 90 U.S.P.Q.2d at 1637. The Board confirmed the trademark examiner's denial and reasoning that the applicant could not limit or restrict the goods listed in the cited registration based on extrinsic evidence. *Id.* at 1638. The Federal Circuit confirmed that the Board had "no authority to read any restrictions or limitations into the registrant's description of goods." *Id.* The same is true here.

The description of services in Opposers' Registration cannot be limited or restricted by any extrinsic evidence, including but not limited to, documents or testimony. Therefore, Applicant cannot rely on the argument that Opposers may have sophisticated consumers to show no likelihood of confusion.

¹² Owen September Depo., 46:15 – 48:18 and Exs. 6 and 7.

F. Similarity of Marks - "PURIFICS" And "PURALYTICS" Are Similar In Sound, Appearance, Connotation And Commercial Impression

1. The Board Must Compare The Marks In Their Entireties And Not Focus Solely On the Prefix "PUR"

In its Main Brief, Applicant focuses only on the prefix of the subject marks and ignores the marks in their entireties. Based on this improper comparison of only the marks' prefixes, Applicant concludes that the marks are dissimilar. In particular, Applicant ignores the fact that both Opposers' and Applicant's marks contain the identical prefix "PUR" and identical suffix "ICS." In doing so, Applicant also ignores the case law that it cites and basic phonetics.

At the outset of its argument, Applicant acknowledges that the Board must compare the marks in their entireties in terms of appearance, sound, and connotation to determine whether they are similar in their overall commercial impressions. Applicant's Main Brief, p. 24 (citing *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1357 (Fed. Cir. 2000)); *see also*, *Time Warner Entertainment Co. v. Jones*, 65 U.S.P.Q.2d 1650, 1660 (T.T.A.B. 2002). Applicant further acknowledges that it is proper for the Board to give more or less weight to particular features of a mark, while still comparing the marks in their entireties. Applicant's Main Brief, p. 24 (citing *Seven-Up Co. v. Tropicana Prods, Inc.*, 356 F.2d 567, 568 (C.C.P.A. 1966)); *see also* *In re National Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985) (finding similar overall commercial impression where marks contained same dominant feature -- "CASH MANAGEMENT" -- despite other differences between marks). After correctly stating the law, Applicant proceeds to dissect the marks into individual elements and compare only the dissected elements.

A proper comparison of the marks under applicable law requires that the marks be compared in their entireties. When this is done, it is clear that the marks have identical dominant

features (prefix "PUR" and suffix "ICS"), and accordingly are similar in sound, appearance, connotation and commercial impression.

2. Similar Sound And Appearance - Compare Marks In Their Entireties, Emphasizing Beginning And End Features Of Each Mark

The Board has routinely held that it is proper to give more weight to **all** significant features of marks in determining the commercial impressions they create. *In re National Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985) (finding similar overall commercial impression where marks contained same dominant feature -- "CASH MANAGEMENT" -- despite other differences between marks). The significant features in Applicant's and Opposers' marks are "PUR" and "ICS."

Applicant acknowledges that "PUR" and "IFICS" are the significant features of the "PURIFICS" and "PURALYTICS" marks: the third-party registrations Applicant submitted to Opposers and made of record in this proceeding contain either the "PUR" prefix or "ICS" suffix.¹³ Yet Applicant now claims that it only considers "PUR" the "similar feature of the marks." Applicant's Main Brief, p. 25 n. 4.

The evidence of record confirms Applicant's original position. During discovery, Applicant produced lists of third-party registrations containing either the prefix "PUR" or the suffix "ICS."¹⁴ Applicant submitted lists of registrations containing the prefix "PUR" or the suffix "ICS" because Applicant, like Opposers, considers "PUR" and "ICS" to be the significant features of the subject marks. Thus, the Board should place greater emphasis on the "PUR" and "ICS" portion of each mark when comparing them in their entireties.

¹³ See Deposition of Mark Owen, January 7, 2013 ("Owen January Depo."), Exs. 121-124, 126.

¹⁴ See Owen January Depo., Exs. 121-124, 126.

When comparing the marks in their entireties and placing the appropriate emphasis on the identical beginning and ending features of each mark, it is clear that the marks look and sound alike. On numerous occasions, the Board has found a likelihood of confusion between marks having the same significant beginning and ending features. As discussed in Opposers' Main Brief, the Board found a likelihood of confusion between the applicant's "TURFECTA" mark for grass seed and the opposer's "TRIFECTA" mark for lawn seed in *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 U.S.P.Q.2d 1826, 1827 (T.T.A.B. 2012). The Board specifically noted that the marks shared the same prefix and suffix. *See id.* at 1832 (emphasis added) (beginning with the letter "T" and ending with the identical element "FECTA"). Likewise, in *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 228 U.S.P.Q. 689 (T.T.A.B. 1986), the Board found a likelihood of confusion between the applicant's "COMM CASH" mark for banking services and the opposer's "COMMUNICASH" mark for banking services. *Id.* at 689 (shared beginning ("COMM") and ending ("CASH") features).

As noted in Opposers' Main Brief, the instant facts are virtually identical to the *Lebanon Seaboard* and *Crocker National Bank* cases. Both Applicant's and Opposers' marks begin with the identical prefix "PUR" and end with the identical suffix "ICS." The prefix and suffix are the significant features of both marks and should carry the greatest weight when comparing the marks in their entireties.

Applicant cites two cases to support its position that the marks are dissimilar. Each case is factually distinguishable from the present dispute. Applicant first cites *Kellogg Co. v. Pack 'em Enters., Inc.*, 951 F.2d 330, 333 (Fed. Cir. 1991), where the Federal Circuit found the marks "FROOT LOOPS" and "FROOTEE ICE" to be dissimilar. Applicant also cites *Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386, 1390 (Fed. Cir. 1989), where the court found "PECAN SANDIES" and "PECAN SHORTEES" to be dissimilar.

In each case, the marks were composed of two separate words, with the first word of each mark being similar to, or a phonetic equivalent of, the other ("FROOT" v. "FROOTEE"; "PECAN" v. "PECAN"). In both cases, the end feature of each mark was completely dissimilar ("LOOPS" v. "ICE"; "SANDIES" v. "SHORTEES"). These situations are unrelated to the marks in this proceeding. Here, the "PURIFICS" and "PURALYTICS" marks contain **identical** beginning and ending features. Further, the contested marks are each one word, not two. In view of the similarity of Applicant's and Opposers' marks and the inapplicability of Applicant's cited case law, it is clear that the marks are very similar in appearance and sound.

3. Connotation - The Marks Suggest Water Purification And Processing To Consumers

In addition to looking and sounding alike, the marks connote the same meaning to consumers. Applicant concedes that both marks begin with the prefix "PUR," which is suggestive of water and/or water purification (Applicant's Main Brief, p. 25), but Applicant argues that the remainder of the marks connote different meanings. *Id.* This is contrary to the testimony of each party's representative.¹⁵ During testimony depositions, each party's representative testified that the company selected its mark to suggest water purification to consumers.¹⁶

The parties even applied the same mental process to select features of the marks to suggest a mental impression to consumers. For example, when selecting the "PURIFICS" mark, Opposers wanted a mark that would suggest what their goods and services were intended to do, *i.e.*, purify water.¹⁷ Similarly, Applicant selected a mark that suggested purification of water.¹⁸

¹⁵ See Butters Depo., 10:21 - 11:11; Owen September Depo. 18:3-18.

¹⁶ Butters Depo., 10:21 - 11:11; Owen September Depo. 18:3-18.

¹⁷ Butters Depo., 10:21 - 11:11.

¹⁸ Owen September Depo., 18:3-18.

As a result, each party selected a mark beginning with the significant feature "PUR" to convey this idea to consumers.

Opposers also wanted a mark that suggested to consumers the idea that the water purification was accomplished using a **photocatalytic** process.¹⁹ Similarly, Applicant's representative admitted that the mental process Applicant employed in identifying its water purification process by a **photocatalytic** method was virtually identical to Opposers'.²⁰ As a result, both parties ended their marks with the prominent feature "ICS." The "PURIFICS" and "PURALYTICS" marks convey very similar commercial impressions to consumers. This factor favors a finding of likelihood of confusion.

G. Lack Of Actual Confusion Does Not Change The Conclusion

Applicant devotes a considerable portion of its Main Brief to the *DuPont* factor of actual confusion. Applicant's Main Brief, pp. 34-35. In particular, Applicant argues that because there is no evidence of actual confusion by a customer, there must be no likelihood of confusion. This, however, is not the test.

"The test of infringement is the **likelihood** of confusion, not the proof of **actual** confusion." 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23.12 (4th Ed. 2012) (emphasis added). Proof of actual confusion is not required in order to find a likelihood of confusion. *See, e.g., Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1186, 207 U.S.P.Q. 278 (5th Cir. 1980) (proof of actual confusion unnecessary; likelihood of confusion is determinative factor).

Opposers have demonstrated that the parties' goods and services are closely related and that their trade channels and consumers overlap. Opposers have demonstrated that the contested

¹⁹ Butters Depo., 10:21 - 11:11.

²⁰ Owen September Depo., 18:3-18.

marks associated with the parties' water purification goods and services are very similar. Accordingly, Opposers have established a likelihood of confusion between the marks. Applicant is asking the Board to hold Opposers to a higher, non-existent standard (*i.e.*, that actual confusion exists). This is not the appropriate test, and Opposers have sufficiently demonstrated a likelihood of success based on the other *DuPont* factors.

H. At Their Discretion, Opposers Have Prevented Third Parties From Using Confusingly Similar Marks

Applicant claims that Opposers have not policed the use of their mark by third parties. Applicant's Main Brief, p. 15. It is well established that a trademark owner is "not required to constantly monitor every nook and cranny of the entire nation and to fire both barrels of [its] shotgun instantly upon spotting a possible infringer." *See Saul Zaentz Co. v. Wozniak Travel, Inc.*, 2008 U.S. Dist. LEXIS 57285, *33 (N.D. Cal. June 29, 2008); *Cullman Ventures, Inc. v. Columbian Art Works, Inc.*, 717 F. Supp. 96, 127 (S.D.N.Y. 1989). Furthermore, a trademark owner is not required to pursue all infringers at the same time. *See, e.g., Daesong Corp. v. Rhee Bros. Inc.*, 77 U.S.P.Q.2d 1753, 1766 and n.15 (D. Md.1988).

Despite having no affirmative obligation to police their mark, Opposers have consistently sent cease and desist letters to, opposed published applications by, and sought to cancel registrations by third parties using confusingly similar marks with related goods and services. For example, Opposers sent cease and desist letters to a third party using the mark "PURIFIC WATER SOLUTIONS" with bottled water. The parties ultimately entered into a settlement agreement prohibiting the third party from continuing that use.²¹ In addition, Opposers obtained cancellation of a third party's registration for the service mark "PURIFIC" with water coolers.

²¹ *See, e.g., Butters Depo.*, 46:14-23, 47:6-7, 48:3, 93:4 - 96:6.

During discovery, Applicant produced lists allegedly showing third-party uses of marks containing the prefix "PUR" or the suffix "ICS."²² Opposers were unaware of these marks prior to Applicant unearthing them during discovery.²³ Some of the cited marks were for goods and services unrelated to water purification goods and services.²⁴ Further, only two of the cited marks contained the significant features of Opposers' mark ("PUR" and "ICS") and appeared to be used with water purification goods and/or services.²⁵ The only issue before the Board is whether Applicant's "PURALYTICS" mark with water purification goods is likely to be confused with Opposers' "PURIFICS" mark with water purification goods and services.

III. CONCLUSION

Applicant attempts to cite extrinsic evidence to artificially limit the scope of its Application in order to avoid the Board finding that Applicant's mark for water purification goods is likely to be confused with Opposers' mark for water purification goods and services. Applicant cannot simultaneously benefit from the broad description in its Application and then, when convenient, retract the scope of its Application. Opposers, properly relying on the contents of the Application and Registration, have demonstrated that the parties have the same goods, trade channels and consumers, as well as very similar marks. Accordingly, Opposers respectfully request that the Board deny registration of the "PURALYTICS" mark for the goods identified in the Application and sustain Opposers' opposition in its entirety.

²² See Owen January Depo., Exs. 121-124, 126.

²³ See, e.g., Butters Depo., 96:17 – 126:11.

²⁴ *Id.*

²⁵ *Id.* (Registration No. 3,473,558, "PURONICS" & Design; Registration No. 3,383,438, "PURONICS").

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on the 10th day of June, 2013, a copy of the foregoing "Reply Brief of Opposers 1047406 Ontario Ltd. and Purifics, ES, Inc." was served, by U.S. Mail, First Class, postage prepaid, upon Applicant's counsel of record as follows:

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